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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,968	04/02/2004	Masashi Ogawa	JG-SIK-5112D	1685
26418 7590 12/18/2006 REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			EXAMINER FERNANDEZ, SUSAN EMILY	
			ART UNIT	PAPER NUMBER
			1651	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/816,968

Applicant(s)

OGAWA ET AL.

Examiner

Susan E. Fernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/045,539.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed September 27, 2006, has been received and entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al. (US 5,985,085) in view of Schutze et al. (Nature Biotechnology. 1988. 16: 737-742).

Baer et al. discloses a "...laser capture microdissection apparatus, comprising: a transfer film carrier having a substrate surface; and a laser capture microdissection transfer film coupled to said substrate surface of said transfer film carrier..." (column 3, lines 41-46). Thus, a device for cutting a biological sample is disclosed comprising a film located on one side of a support. It

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is noted that the film can be considered a "colored film" since the transfer film is manufactured containing organic dyes which selectively absorb certain wavelengths (column 2, lines 37-39). Additionally, the substrate surface included in the device, which is the support, is a plate that can be fabricated from glass (column 5, lines 51-52). As shown on Figures 5A and 5C, the transfer film is located on one side of the substrate surface.

Baer et al. does not expressly disclose that the thickness of the transfer film is in the range of from 3 to 6 μm located on one side of the support.

However, Baer et al. indicates that: "it is advantageous that the LCM transfer film 400 be thin. For example, a 50 micron thick film is preferable to a 100 micron thick film. However, the film can advantageously be fabricated in thicknesses of approximately 500, 400, 300, 200, 100, 50 microns **or less**" (column 6, lines 32-37, emphasis added).

Thus, although Baer et al. does not explicitly disclose the claimed film thickness range, Baer clearly discloses the desirability of using thin films. The artisan of ordinary skill would therefore have been motivated to have employed a film having the claimed thickness in the process disclosed by Baer et al. Moreover, Schutze et al. discloses laser microbeam microdissection as well. As in Baer et al., Schutze et al. teaches the placement of a transfer film (polyethylene membrane) on a surface (glass slide). See page 738, particularly Figure 1. The thickness of the transfer film in the device disclosed in Schutze et al. is 1.35 μm (Figure 1). Therefore, one of ordinary skill in the art would have been motivated to have used transfer film thicknesses such as those recited since the prior art had shown that even a thickness as low as 1.35 μm would have been appropriate for laser microbeam microdissection.

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Lastly, the determination of a suitable polymer film, such as the aramid recited in claim 14, must be considered obvious in view of Baer's disclosure that a wide variety of polymeric films are suitable in the processes disclosed therein. See column 8, lines 33-42.

Applicant's arguments filed September 27, 2006, have been fully considered but they are not persuasive. Applicant asserts that Baer et al. does not suggest or disclose an extremely thin film with a thickness of 3 to 6 microns. However, it is respectfully pointed out that Baer et al. teaches that it is advantageous that a thin film be used, and that it can be less than 50 microns (column 6, lines 32-37). Moreover, Baer et al. is combined with Schutze et al. which teaches laser microbeam microdissection where a transfer film that is 1.35 microns thick is used. Thus, there would have been a reasonable expectation of success in use a transfer film thickness such as the one disclosed in Schutze et al., and there would have been motivation to do so since Baer et al. indicates it is advantageous to use a thin film. Indication in Baer et al. that it is advantageous to use a thin film is sufficient motivation to use thicknesses as small as the ones in the range recited in instant claim 14. The fact that applicant has recognized other advantages (improved adhesion to a glass slide, improved micro dissection suitability, improved cutting sharpness) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

Finally, applicant indicates that Baer et al. nor Schutze et al. disclose or render obvious the use of an aramid film. However, it is respectfully noted that Baer et al. indicates that the film can be "any suitable thermoplastic" (column 8, line 34). Aramid is a known thermoplastic (see Conklin et al., US 4,540,610, column 7, line 37), and therefore, as discussed in the prior office action, it would have been obvious to have used a variety of polymeric films, included aramid

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film. Thus, a holding of obviousness is clearly required.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

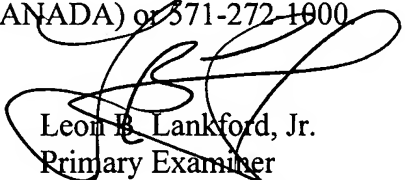
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan E. Fernandez whose telephone number is (571) 272-3444. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan E. Fernandez
Assistant Examiner
Art Unit 1651



Leon B. Lankford, Jr.
Primary Examiner
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sef